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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/786,148	02/26/2004	Shiu-Ru Lin	BHT/3230-85	8192

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EXAMINER

WESSENDORF, TERESA D

ART UNIT	PAPER NUMBER
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1639

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/786,148

Applicant(s)

LIN ET AL.

Examiner

T. D. Wessendorf

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final *for restriction only.*
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-79 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-79 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Election/Restrictions

Restriction to one of the following inventions is required under 35 U.S.C. 121:

1. Claim 1, drawn to genes for diagnosing colorectal cancer, classified in class 435, subclass 6.
2. Claims 2 and 3, drawn to genes for detecting or diagnosing colorectal cancer having any one of the recited sequences 1-71, classified in class 435, subclass 4+.
3. Claims 2 and 4, drawn to genes for testing biochip, classified in class 435, subclass 4+.
4. Claims 2 and 5, drawn to genes for medicine, classified in class 435, subclass 4+.
5. Claims 2 and 6, drawn to genes for protein testing reagent, classified in class 435, subclass 4+.
6. Claims 2 and 7, drawn to genes for a protein for curing medicine, classified in class 435, subclass 4+.
7. Claims 2 and 8, drawn to genes for vaccine, classified in classes 435 and 424, subclasses 4+ and 9.1+, respectively.

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8. Claim 9, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
9. Claim 10, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
10. Claim 11, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
11. Claim 12, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
12. Claim 13, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
13. Claim 14, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
14. Claim 15, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
15. Claim 16, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
16. Claim 17, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
17. Claim 18, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
18. Claim 19, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.

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19. Claim 20, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
20. Claim 21, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
21. Claim 22, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
22. Claim 23, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
23. Claim 24, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
24. Claim 25, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
25. Claim 26, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
26. Claim 27, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
27. Claim 28, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
28. Claim 29, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
29. Claim 30, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.

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30. Claim 31, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
31. Claim 32, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
32. Claim 33, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
33. Claim 34, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
34. Claim 35, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
35. Claim 36, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
36. Claim 37, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
37. Claim 38, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
38. Claim 39, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
39. Claim 40, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
40. Claim 41, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.

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41. Claim 42, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
42. Claim 43, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
43. Claim 44, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
44. Claim 45, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
45. Claim 46, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
46. Claim 47, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
47. Claim 48, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
48. Claim 49, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
49. Claim 50, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
50. Claim 51, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
51. Claim 52, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.

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52. Claim 53, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
53. Claim 54, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
54. Claim 55, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
55. Claim 56, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
56. Claim 57, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
57. Claim 58, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
58. Claim 59, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
59. Claim 60, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
60. Claim 61, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
61. Claim 62, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
62. Claim 63, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.

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63. Claim 64, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
64. Claim 65, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
65. Claim 66, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
66. Claim 67, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
67. Claim 68, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
68. Claim 69, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
69. Claim 70, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
70. Claim 71, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
71. Claim 72, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
72. Claim 73, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.
73. Claim 74, drawn to gene sequence as set forth therein,
classified in class 435, subclass 4+.

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- 74. Claim 75, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
- 75. Claim 76, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
- 76. Claim 77, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
- 77. Claim 78, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.
- 78. Claim 79, drawn to gene sequence as set forth therein, classified in class 435, subclass 4+.

The inventions are distinct, each from the other because of the following reasons:

Inventions 1-78 are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different designs, modes of operation, and effects (MPEP § 802.01 and § 806.06). In the instant case, the different inventions are drawn to structurally different compounds, genes. Each of the genes has different structures and possibly modes of operation or effects, as evidenced by the different uses of said genes (groups 3-7).

Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter,

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and the inventions require a different field of search (see MPEP § 808.02), specifically the literature journals, restriction for examination purposes as indicated is proper.

Claim 2 is generic to the following disclosed patentably distinct species: genes as recited in (1)-(71). The species are independent or distinct because each of the genes differs in structure and/or effects. A prior art reference anticipating one species would not render obvious the other species.

Applicant(s) is/are required under 35 U.S.C. 121 to elect a single disclosed species (*i.e., only one species e.g., (1)*) for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

Applicant(s) is/are advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant(s) will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37

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CFR 1.141. If claims are added after the election, applicant(s) must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant(s) traverse on the ground that the species are not patentably distinct, applicant(s) should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant(s) is/are advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

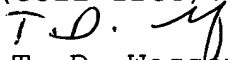
Applicant(s) is/are reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to T. D. Wessendorf whose telephone number is (571)272-0812. The examiner can normally be reached on Flexitime.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Paras can be reached on (571)272-4517. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


T. D. Wessendorf
Primary Examiner
Art Unit 1639

Tdw
May 15, 2006